

REMARKS

Claims 1-10 are pending in the present application. Claims 1-10 are rejected. Claim 10 is herein amended. No new matter is believed to have been entered through the claim amendment. Furthermore, upon belief, it is respectfully submitted that this paper is fully responsive to the outstanding Office Action.

Objection to the Drawings

FIG. 6 of the present application was objected to.

The Examiner has requested that extraneous Japanese characters be removed from the drawings. Herein submitted is a replacement sheet with FIG. 6 having been amended further to the helpful suggestions of the Examiner.

In view of the foregoing, it is respectfully requested that the objection be withdrawn.

Claim Rejections - 35 U.S.C. §112

Claims 1-10 were rejected under 35 U.S.C. §112, second paragraph as being indefinite.

The rejection is respectfully traversed.

The Examiner specifically contends that the recitation of claim 1 of, "for giving an arbitrary amount of advance/retraction to the first output shaft and constantly giving to the second output shaft an amount of advance/retraction at a constant ratio ($\neq 1$) with respect to the amount of advance/retraction given to the first output shaft," renders the claim vague and

indefinite because it is allegedly unclear how an arbitrary amount of advance/retraction can be given to the first output shaft while constantly giving to the second output shaft an amount of advance/retraction at a constant ratio ($\neq 1$).

The Federal Circuit has repeatedly annunciated that the law is clear that if the claims, read in light of the Specification, reasonably apprise those skilled in the art of the use and scope of the invention, and if the language is as precise as the subject matter permits, the claims are definite under Section 112, second paragraph.

As a non-limiting example in at least one embodiment of the present application, the Specification provides support for the aforementioned recitation at page 9, line 15 to page 11, line 19.

Further, the above arguments regarding independent claim 1 are applicable where appropriate toward independent claim 9. Further, claims 2-8 and 10 which depend from either independent claim 1 or independent claim 9 are patentable for at least the reason of their dependency therefrom.

In view of the foregoing, it is respectfully submitted that the rejection is overcome.

Claim Rejections - 35 U.S.C. §102

Claims 1, 8/1 and 10/1 were rejected under 35 U.S.C. §102(b) as being anticipated by Paltieli (US 5,647,373).

The rejection is respectfully traversed.

It is respectfully submitted that the cited art does not describe all of the recitations of at least claim 1 of the present application. Specifically, it is submitted that the cited art fails to describe at least the recitation of claim 1 of, "drive means for giving an arbitrary amount of advance/retraction to the first output shaft and constantly giving to the second output shaft an amount of advance/retraction at a constant ratio ($\neq 1$) with respect to the amount of advance/retraction give to the first output shaft...." Further, the Examiner is respectfully reminded that all recitations of a claim must be considered in a patentability determination.

Paltieli relates to an articulated needle guide for ultrasound imaging and method of using the same and describes an angular adjustment of a needle in a second sense of a direction, by a second reciprocatingly acting servo-motor 45 which serves to change the length of a link 41, 42 which is firmly attached to an upper lug 7 by socket means and is at its other end rigidly connected to the end of shaft 40. (Paltieli; column 4, lines 43-48).

As such, the servo-motor 45 of Paltieli only advances or retracts the length of link 41, 42. This assertion is furthered by FIG. 2 of Paltieli which explicitly shows with left and right pointing arrows that 41, 42 advance or retract, while second link 43 does not advance or retract.

Additionally, Paltieli specifically states that, "the link includes a sleeve 41 which contains a bar 42 in longitudinally sliding arrangement moved in or out of the sleeve by servo motor 45. The needle guide is additionally connected to the shaft end by a second link 43 which has its one end pivotally connected to the shaft end (44) and its other end rigidly connected to the lower lug 7 of the needle guide by socket means. By shortening or lengthening link 42, the angle of the needle axis is changed in respect of the skin surface in the plane dictated by the

rotation of shaft 40, and the combined action of the two servo-motors brings the needle axis into accurate aiming position onto the target." (Paltieli; column 4, lines 48-57). As such, it is respectfully submitted that the cited art fails to describe at least the drive means recitation of claim 1 of the present application.

Regarding claim 10, it is respectfully submitted that the cited art fails to describe at least the recitations of its base claim, independent claim 9. Further, the cited art fails to describe or teach at least the recitation of claim 10 of, "the movable member is a surgical instrument for medical care and that a distal end of the surgical instrument is positioned with respect to an area to be treated."

Additionally, claim 8 is patentable for at least the reason of its dependency from independent claim 1. Separate and individual consideration of the dependent claims is respectfully requested.

In view of the foregoing, it is respectfully submitted that the rejection is overcome.

Claim 9 was rejected under 35 U.S.C. §102(b) as being anticipated by Ogawa et al. (US 5,577,414).

The rejection is respectfully traversed.

It is submitted that the cited art does not describe all of the recitations of at least claim 9 of the present application. Specifically, the cited art fails to describe at least the recitation of claim 9 of, "drive means for giving an arbitrary amount of advance/retraction given to the first output shaft and constantly giving to the second output shaft an amount of advance/retraction at a

constant ratio ($\neq 1$) with respect to the amount of advance/retraction give to the first output shaft...."

The Examiner contends on page 5 of the outstanding Office Action that, "the first unit including: 'first and second output shafts' (FIG. 5, elements #5 and #52) whose distal ends are pivotably connected with the movable member via element #53 and which are provided parallel to each other and capable of reciprocating wherein forward movement in one direction constitutes advance and movement in an opposite direction constitutes retraction (FIGS. #4 and #5); and motor or 'drive means' (23 and 51)...." It is submitted that the Examiner has mischaracterized the recitations of claim 9 of the present application, and has thereby improperly applied Ogawa in the outstanding Office Action.

Ogawa relates to an articulated robot and describes through a fourth embodiment in FIG. 5 a second arm 5, a second auxiliary link 4, a first auxiliary lifting link 52 and a second lifting auxiliary link 53 forming a parallelogrammic linkage. (Ogawa; column 3, line 66 to column 4, line 2). Further, Ogawa states (through the second embodiment of FIG. 3) that, "a third drive motor 51 turns a second arm 5 on its base end in a vertical plane ... thus, the front end of second arm 5 and all the components mounted on the front end of the second arm 2 can be moved up and down."

It is submitted that a person of ordinary skill in the art would not interpret Ogawa's teaching of a second arm 5 that essentially moves up and down which is moved through a third drive motor 51 as "advancing/retracting" as recited in claim 9 of the present application. Instead, the second arm 5, which the Examiner correlates with one of the first and second output

shafts of claim 9 of the present application, is a non-extendable element that turns in a circular direction through its base end in a vertical plane. As such, the cited art fails to describe at least the aforementioned recitations of claim 9 of the present application.

In view of the foregoing, it is respectfully submitted that the rejection is overcome.

Claim Rejections - 35 U.S.C. §103

Claims 2, 8/2 and 10/2 were rejected under 35 U.S.C. §103(a) as being unpatentable over Paltieli (US 5,647,373) in view of Jensen (US 5,800,423).

Claims 3, 4, 8/3, 8/4, 10/3 and 10/4 were rejected under 35 U.S.C. §103(a) as being unpatentable over Paltieli (US 5,647,373) in view of Jensen (US 5,800,423) and further in view of Falcou (US 6,928,894).

Claims 5, 8/5, 10/5 were rejected under 35 U.S.C. §103(a) as being unpatentable over Paltieli (US 5,647,373) in view of Taylor (US 5,397,323).

Claims 6, 8/6 and 10/6 are rejected under 35 U.S.C. §103(a) as being unpatentable over Paltieli (US 5,647,373) in view of Taylor et al (US 5,397,323) further in view of Luce (US 5,381,396).

Claims 7, 8/7 and 10/7 were rejected under 35 U.S.C. §103(a) as being unpatentable over Paltieli (US 5,647,373) in view of Taylor et al (US 5,397,323) further in view of Surdilla (US 4,515,296).

The above rejections are respectfully traversed.

As the above rejections are over claims 2-8 and 10 over Paltieli, the comments presented above regarding independent claim 1 are applicable here also as said claims (e.g. claims 2-8) depend directly or indirectly from independent claim 1. Further, the dependent claims are patentable for at least the reason of their dependency therefrom. Claim 10 is here amended to depend from independent claim 9; however, it is submitted that Paltieli fails to describe or teach the recitations of independent claim 9. Further, nothing has been cited in the other references (e.g. Jensen, Falcou, Taylor, Luce or Surdilla) which cures the deficiencies of Paltieli.

In view of the foregoing, it is respectfully submitted that the above rejections are overcome.

Official Notice

On page 7 of the outstanding Office Action, the Examiner contends, “since Paltieli and Jensen teach known devices, i.e. devices for controlling movement of surgical instrument during surgery, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided the output shafts of Paltieli with threading, as taught by Jensen, for the predictable result of providing accurate positional control during manipulation by controlling axial length adjustment.” Although the Examiner has not specifically stated “Official Notice” in the outstanding Office Action, it appears as if the Examiner is taking Official Notice.

Similarly, the Examiner contends on page 8 of the outstanding Office Action, “because the devices of Paltieli and Taylor et al teach known devices, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have applied the technique of

racks and pinions to the positioning device of Paltieli, as taught by Taylor et al for the predictable result of providing constraint with angle adjustment procedures. Further, the Examiner makes similar contentions at page 9 of the Office Action, (therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have applied the known technique ... for enhanced control of the positioning device) and at page 10 of the Office Action, (therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have applied the known technique ... for the predictable result of providing different speeds to each output shaft for enhanced control of the positioning device).

The Examiner's aforementioned statements (and taking of Official Notice) are respectfully traversed. As required by the MPEP, the Examiner is respectfully requested to provide documentary evidence for his assertions. (See MPEP 2144.03).

In view of the aforementioned amendments and accompanying remarks, Applicants submit that the claims, as herein amended, are in condition for allowance. Applicants request such action at an early date.

If the Examiner believes that this application is not now in condition for allowance, the Examiner is requested to contact Applicants' undersigned attorney to arrange for an interview to expedite the disposition of this case.

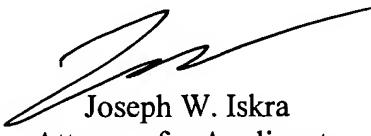
Application No.: 10/531,994
Art Unit: 4133

Amendment under 37 C.F.R. §1.111
Attorney Docket No.: 052448

If this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. The fees for such an extension or any other fees that may be due with respect to this paper may be charged to Deposit Account No. 50-2866.

Respectfully submitted,

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